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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
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2155

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/752,804	Applicant(s) KIRKLAND ET AL.	
	Examiner Michael Y. Won	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/7/04 & 3/6/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the application filed January 7, 2004.
2. Claims 1-39 have been examined and are pending with this action.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 27-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The language of claim 27 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

The applicant(s) claim "a computer readable medium" but does not define within the body of the claim the hardware in which the invention runs. Thus, absent recitation of the server or some other hardware, claim 27 is not limited to a tangible embodiment, instead being sufficiently broad to encompass software, per se.

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The examiner encourages applicant to define within the claims the embodied features and limitations on a "storage" computer readable medium such as hard drives, disks, and other hardware elements. An example of a proper format would be "a computer program product"... "encoded in a computer readable storage medium".

Furthermore on page 30, of the specification, the applicant(s) have provided evidence that the applicant intends the medium to include signals as such that the claim is drawn to a form of energy (carrier wave, transmission-type media or other propagation medium). Energy is not one of the four categories of invention and therefore this claim is not statutory. Energy is not a series of steps or acts and thus not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not combination of substances and therefore not a composition of matter. Appropriate correction in the specification is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1, 14, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The examiner cannot conclude from the broad language of the claims, “responsive to user input on the first user device, selectively causing the new topic session to be replicated on secondary user devices associated with the first user”, whether the secondary user device is a device of the first user or a device of the second user transmitted via said network.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-8, 12-21, 25-34, 38 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Malik (US 2004/0078445).

INDEPENDENT:

As per **claim 1**, Malik teaches a method for communication between a plurality of devices remotely connected via a network, comprising:

within an existing instant messaging session on a first user device associated with a first user, responsive to user input, initiating a new topic

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session (see page 6-page 7, [0066]: “(an IM chat session that is already in progress)... (a newly-established IM chat session)”);

within the existing instant messaging session on the first user device, responsive to user input on the first user device, selectively causing the new topic session to be replicated on secondary user devices associated with the first user (see page 2, [0029]: “IM client may automatically forward incoming IM messages to other IM addresses”); and

providing a user interface on the first user device, which is capable of distinguishing between data intended for the existing and new sessions (see page 6, [0059], [0063]: “Mercutio’s exchange with Juliet may be hidden from Romeo”, and [0066]: “three-way IM chat sessions may be seen as merging of two separate IM chat sessions”).

As per **claim 14**, Malik teaches a data processing system for communication between a plurality of devices remotely connected via a network, comprising:

means for initiating a new topic session within an existing instant messaging session on a first user device associated with a first user in response to user input (see page 6-page 7, [0066]: “(an IM chat session that is already in progress)... (a newly-established IM chat session)”);

means for selectively causing the new topic session to be replicated on secondary user devices associated with the first user within the existing instant messaging session on the first user device in response to user input on the first

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user device (see page 2, [0029]: "IM client may automatically forward incoming IM messages to other IM addresses"); and

means for providing a user interface on the first user device, which is capable of distinguishing between data intended for the existing and new sessions (see page 6, [0059], [0063]: "Mercutio's exchange with Juliet may be hidden from Romeo", and [0066]: "three-way IM chat sessions may be seen as merging of two separate IM chat sessions").

As per **claim 27**, Malik teaches a computer program product in a computer readable medium for communication between a plurality of devices remotely connected via a network, comprising:

first instructions for initiating a new topic session within an existing instant messaging session on a first user device associated with a first user in response to user input (see page 6-page 7, [0066]: "(an IM chat session that is already in progress)... (a newly-established IM chat session)");

second instructions for selectively causing the new topic session to be replicated on secondary user devices associated with the first user within the existing instant messaging session on the first user device in response to user input on the first user device (see page 2, [0029]: "IM client may automatically forward incoming IM messages to other IM addresses"); and

third instructions for providing a user interface on the first user device, which is capable of distinguishing between data intended for the existing and new sessions (see page 6, [0059], [0063]: "Mercutio's exchange with Juliet may

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be hidden from Romeo”, and [0066]: “three-way IM chat sessions may be seen as merging of two separate IM chat sessions”).

DEPENDENT:

As per **claims 2, 15, and 28**, which respectively depend on claims 1, 14, and 27, Malik further teaches wherein the first and secondary user devices include a desktop computer, a laptop computer, a cellular phone, a personal digital assistant, and a fax machine (see page 2, [0029] and page 3, [0034]).

As per **claims 3, 16, and 29**, which respectively depend on claims 1, 14, and 27, Malik further teaches wherein the user input, is performed by selecting a button in a messaging window (see Fig. 11A and page 6, [0060]).

As per **claims 4, 17, and 30**, which respectively depend on claims 1, 14, and 27, Malik teaches further comprising:

determining if the recipient has more than one device capable of receiving instant messages (see page 2, [0030]);

selectively sending the message to the recipient's devices (see page 2, [0030]).

As per **claims 5, 18, and 31**, which respectively depend on claims 4, 17, and 30, Malik further teaches wherein the user conducts an instant messaging session, which was initiated on the first user device with the recipient using one of the secondary devices (see page 2, [0030]).

As per **claims 6, 19, and 32**, which respectively depend on claims 1, 14, and 27, Malik further teaches wherein selectively causing the new topic session

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to be replicated on a second user device is performed by sending the message to all of the user's secondary devices (see page 2, [0029]).

As per **claims 7, 20, and 33**, which respectively depend on claims 1, 14, and 27, Malik further teaches wherein selectively causing the new topic session to be replicated on a second user device, is performed by sending the message to the user's secondary devices in a priority sequence until a receipt notification is obtained (see page 2, [0030]).

As per **claims 8, 21, and 34**, which respectively depend on claims 1, 14, and 27, Malik further teaches wherein the user interface on the first user device distinguishes between data intended for the existing and new sessions by organizing the data in a topical manner (see page 6-page 7, [0066]).

As per **claims 12, 25, and 38**, which respectively depend on claims 1, 14, and 27, Malik further teaches wherein at least one participant in the instant messaging session has a capability to display multiple threads of conversation in multiple devices, and at least another participant in the instant messaging session does not have the capability to display multiple threads of conversation in multiple devices (inherency: if one participant comprises devices capable of engaging in IM communication (see page 3, [0034]), clearly one is capable of communicating in plural IM sessions via each device. On the contrary if another participant does not comprise plural devices capable of engaging in IM communication, clearly one is not capable of communicating in plural IM sessions via plural devices).

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As per **claims 13, 26, and 39**, which respectively depend on claims 4, 17, and 30, Malik further teaches wherein the message received at a recipient device may be forwarded to another recipient device (see page 2, [0030]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9-11, 22-24, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik (US 2004/0078445) in view of Chen (US 6,392,997).

As per **claims 9, 22, and 35**, which respectively depend on claims 1, 14, and 27, although Malik teaches wherein the message is to be replicated on particular secondary user devices associated with the first user (see page 2, [0029]), Malik does not teach that the indication is by a header information in the message.

Chen teaches an indication by header information in the message (see col.3, lines 27-34).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Malik in view of Chen by

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implementing an indication by header information in the message. One would be motivated to do so because message headers are well known in the art to be used for providing directives associated with the message.

As per **claims 10, 23, and 36**, which respectively depend on claims 4, 17, and 30, although Malik teaches wherein the message is to be replicated on particular secondary user devices associated with the recipient (see page 3, [0034]), Malik does not teach that the indication is by a header information in the message.

Chen teaches an indication by header information in the message (see col.3, lines 27-34).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Malik in view of Chen by implementing an indication by header information in the message. One would be motivated to do so because message headers are well known in the art to be used for providing directives associated with the message.

As per **claims 11, 24, and 37**, which respectively depend on claims 10, 23, and 36, although Malik teaches wherein the user may update an outgoing message, Malik does not teach updating the header information.

Chen teaches updating the header information (see col.3, lines 10-20).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Malik in view of Chen so that the header information is updated. One would be motivated to do so

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because message headers are well known in the art to be used for providing directives associated with the message.

Conclusion

7. For the reasons above claims 1-39 have been rejected and remain pending.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Won/

Primary Examiner

August 2, 2007